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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,673	03/24/2006	Masamichi Furukawa	0670-7072	5077
31780	7590	07/24/2009		
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EXAMINER				
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ART UNIT		PAPER NUMBER		
2437				
MAIL DATE		DELIVERY MODE		
07/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,673

**Applicant(s)**

FURUKAWA ET AL.

**Examiner**

JEFFERY WILLIAMS

**Art Unit**

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 17-20 and 22-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4, 17-20 and 22-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date 3/24/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to the communication filed on 4/20/09.

Claims 1 – 4, 17 – 20, and 22 – 25 are pending.

All objections and rejections not set forth below have been withdrawn.

#### ***Claim Objections***

Claims 18 and 22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, an claimed apparatus is limited by structure (i.e. defined by what it is) not how it is used. These claims essentially comprise descriptive recitations related to intended use and they fail to further limit the claimed apparatus.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 – 4 and 17 – 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Morito et al. (Morito), U.S. Patent 6,310,956.**

Regarding claim 1, Morito discloses:

*A digital watermark information adding device having digital watermark information adding means for adding two kinds of digital watermark information to broadcast content data (Morito, 5:26-47; 7:55-8:6; Abstract; 5:5-8; fig. 5:23), wherein said two kinds of digital watermark information are first digital watermark information having the type of data or medium of said broadcast content data to be set and second digital watermark information having time information representing broadcasting time of said broadcast content data to be set and wherein the broadcasting time represented by the time information set in said second watermark information is utilized to judge whether or not a terminal receiving said broadcast content data should record the content data.* Herein, Morito clearly discloses a device structure comprising a watermark adding means for adding two types of watermark information to broadcast content data.

Regarding claim 2, it is rejected for the same reasons as claim 1, and furthermore because Morito discloses:

*A digital watermark information adding device having digital watermark information adding means for adding first digital watermark information to broadcast*

*content data (Morito, Abstract; 5:5-8; fig. 5:23; 5:26-47; 7:55-8:6), said first digital watermark information having the type of data or medium of said broadcast content data to be set, wherein said digital watermark information adding means further operates to add second digital watermark information having time information representing broadcasting time of said broadcast content data to be set to said broadcast content data, to allow a terminal receiving the broadcast content data which has been redistributed via a network.*

Regarding claims 3 and 4, Morito discloses:

*wherein said digital watermark information adding means adds digital watermark information (Morito, Abstract:3-12; fig. 5) representing that the broadcast content insists the copyright to said broadcast content data, and wherein said digital watermark information adding means adds digital watermark information (Morito, Abstract:3-12; fig. 5) representing whether or not the broadcast content data is permitted to be distributed via a communication line.*

Regarding claim 17, it is rejected for the same reasons as claims 1 and 2, and furthermore because Morito discloses:

*input means for inputting content data to which two kinds of digital watermark information is added, said two kinds of digital watermark being first digital watermark information having the type of data or medium of said input content data to be set and*

*second digital watermark information having time information representing recording or distributing time to be set (Morito, 5:26-47; 7:55-8:6; Abstract; 5:5-8; fig. 5:23);*

*time information identification means for identifying time information added to said input content data from said second digital watermark information (Morito, fig. 6:33);*

*clocking means for clocking the present time (Morito, fig. 6:34);*

*and recording means for recording said input content data in a recording medium and control means for causing the input content data to be recorded in said recording medium (Morito, fig. 6:30) if it is discriminated that the time information is added to said input content data, and the time information identified by said time information identification means and the present time clocked by said clocking means are matched within a predetermined range.*

Regarding claims 18 – 20, and 22 – 25, as best can be understood, Morito discloses:

*wherein if it is discriminated that the time information is added to said input content data, and identified time information and the present time clocked by said clocking means are unmatched within a predetermined range, said control means operates to prohibit recording the input content data from being recorded in said recording medium (Morito, Abstract); copyright insistence information discrimination means for discriminating whether or not information representing the insistence of the copyright is added to said input content data, wherein if it is discriminated that the time information*

*is not added to said input content data, and it is discriminated that the information representing the insistence of the copyright is added, recording the input content data in said recording medium is prohibited (Morito, Abstract; fig. 6:33); copyright insistence information discrimination means for discriminating whether or not information representing the insistence of the copyright is added to said input content data, wherein if it is discriminated that the time information is not added to said input content data, and it is discriminated that the information representing the insistence of the copyright is not added, the input content data is recorded in said recording medium (Morito, Abstract; fig. 6:33); wherein said control means operates to add information representing the insistence of the copyright as digital watermark information to said input content data; wherein said clocking means is able to set the time clock at the time of manufacture of said data recording device (Morito, 6:58-60); wherein said clocking means clocks the year, month and day, and said time information includes only the year, month and day (Morito, 5:56-63; 7:1-12); wherein said clocking means imposes a restriction on the number of times the time clock can be set (7:21-36).*

### ***Response to Arguments***

Applicant's arguments filed 4/20/09 have been fully considered but they are not persuasive.

*Applicant argues essentially that:*

In response, claim 18 has been amended to recite that "said control means operates to prohibit the input content data from being recorded in said recording medium;" and claim 22 has been amended to recite that "said control means operates to add information representing the insistence of the copyright as digital Watermark information to the input content data." The Applicant respectfully submit that amended claims 18 and 22 clearly further limit the subject matter of a previous claim and specifically further limit the claimed apparatus. (Remarks, pg. 8)

*Examiner responds:*

The examiner respectfully reminds the applicant that a claimed apparatus is limited by structure (i.e. defined by what it is) not how it is used. "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The examiner maintains that recitations such as "*said control means operates to*" fail to further differentiate the claimed apparatus.

*Applicant argues essentially that:*

Independent claims 1, 2 and 17 have been amended to include additional features relating to the digital watermark information, among other features. Specifically, ... The Applicant respectfully submits that Morito does not teach the above-referenced features of the present invention, either explicitly or inherently. (Remarks, pg. 10, 11)



*Examiner responds:*

The examiner respectfully notes that the applicant's argument essentially comprises only the allegation that the newly added amendments render the claims novel in view of the prior art. In response, the examiner directs the applicant to the above rejections.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without *specifically pointing out how* the language of the claims patentably distinguishes them from the references.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

***See Notice of References Cited.***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery Williams/  
Examiner, Art Unit 2437

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2437

